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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,660	11/26/2003	Rick James Morse	D0932-00428 [VS-8855]	8809
8933 7590 02/19/2009 DUANE MORRIS LLP - Philadelphia IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196			EXAMINER BUCKLE JR, JAMES J	
			ART UNIT 3633	PAPER NUMBER
			MAIL DATE 02/19/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/723,660

**Applicant(s)**

MORSE, RICK JAMES

**Examiner**

JAMES J. BUCKLE JR

**Art Unit**

3633

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-13, 15-17, 22-27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 15-17, 22-27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/6/2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/23/2008.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The following is a Non-Final office action in response to communication received on 12/23/2008. Claims 1, 3- 4, 6-7, 9, 12-13, 15-17 and 24-27 have been amended. Claims 5, 14, 18, 20-21 and 28 have been canceled. Currently claims 1-4, 6-13, 15-17, 22-27, and 29-30 are pending and examined below.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/23/2008 has been entered.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 12/23/2008 is being considered by the examiner.

#### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "a region of increasing thickness" and "a transition region" recited in claim 1.

***Claim Objections***

4. Claim 25 objected to because of the following informalities: line 7 in claim 25 recites "fact" and "planar from" respectively, examiner believes applicant meant to recite "face" and "planar form" respectively. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

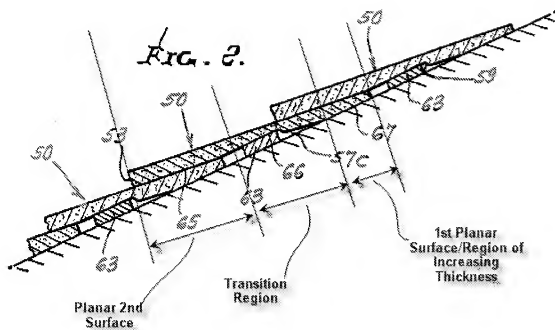
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

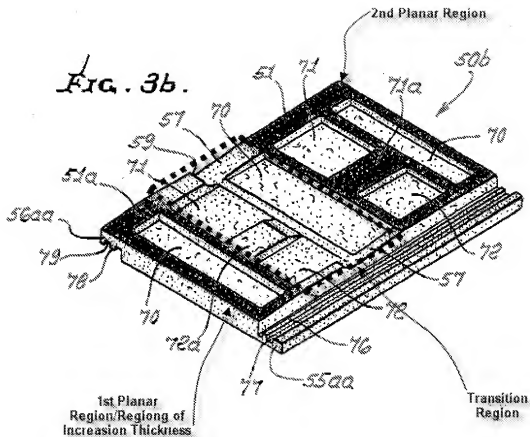
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Jakel (U.S. Patent No. 5,465,547).
7. Regarding claim 1, Jakel discloses a rectangular siding panel (50, Figures 1-3b) having front (52) and rear faces (51), first (55) and second (56) side faces and top (53) and bottom faces (54), said panel having a region of increasing thickness (Region of Increasing Thickness, Examiner Amended Fig. 2 and 3b) extending from said top face to a transition region (Transition Region), said rear face in said region of increasing thickness forming a substantially planar first surface (1<sup>st</sup> Planar Surface) defined from said first side face to said second side face that extends, in substantially continuous planar form, from said top face to said transition region (Examiner considers the shaded area in figure 3b to be in one plane distant to the plane of the area approximate "70"

and consist of no discontinuities throughout the shaded area making it thus making it continuous), said rear face having a substantially planar second surface (2<sup>nd</sup> Planar Surface) occupying a majority of said rear face defined from said first side face to said second side face that extends, in substantially continuous planar form, from said bottom face to said transition region (As illustrated in Figures 2 and 3b, the examiner considers the 2<sup>nd</sup> Planar surface to occupy the majority of the rear face out of the three regions), wherein said region of increasing thickness and transition region cooperate to permit the substantially planar first surface to sit substantially flush with a portion of a vertical wall when said siding panel is secured to said vertical wall and angled to overlap at least a portion of a second siding panel secured to said vertical wall with a portion of said rear face at proximate a bottom end of said panel resting upon a front face of said second siding panel.



Reproduced from U.S. Patent No. 5,465,547



Reproduced from U.S. Patent No. 5,465,547

8. Regarding claim 3, Jakel disclose the siding panel as being fiber cement (Col. 4, lines 22-27).

**Claim Rejections - 35 USC § 103**

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 2, 27 and 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jakel (U.S. Patent No. 5,465,547) in view of the Applicant's Admitted Prior Art (AAPA).

11. Regarding claim 2, Jakel discloses the siding panel as set forth above, but does not specify the panel as being a clapboard, however AAPA teaches that a clapboard is a commonly used as a siding panel installed on a wall of a structure. Therefore, it would have been obvious at the time of the invention to one having ordinary skill in the art to have applied the teachings of Jakel including a thickened portion proximate a top end forming a protruding first area, into a clapboard so as to flatly engage the wall and subsequently provide leverage that resist wind up-lifts forces exerted on the panel ultimately preventing any type breakage.

12. Claims 27 and 29 are rejected as set forth in claim 1-3 above.

13. Claims 4, 8 and 10 are rejected as being unpatentable over the Jakel in view of DeFord et al. (U.S. PG Pub 2002/0139082).

14. Regarding claims 4, 8, and 10, Jakel discloses the a rectangular shaped clapboard siding panel as set forth above, but does not disclose the reinforcing area comprises an embedded or laminated reinforcement layer or comprising a mesh, scrim, fabric or panel reinforcement. However, Deford et al. teaches that it is known in the art to have a siding panel that comprises of a embedded reinforcement layer that comprises of scrim (para [0016], [0035], [0089]-[0090]) to improve strength and adequately improve the resistance and impact of bending torques that are applied to



building under wind loading conditions or other conditions normally faced by building structures. There fore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the siding panel as disclosed by Jakel with the reinforcement as taught by DeFord et al. to provide a siding panel that was lightweight, economical and maintained the structural integrity and adequate reinforcement to resist forces that a building is normally subjected.

15. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakel (U.S. Patent No. 5,465,547).

16. Regarding claim 6, Jakel discloses a siding panel as set forth above with the planar first surface (1<sup>st</sup> Planar Surface) having a height, but Jakel does not specify the height as being about at least one inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a planar first surface of about at least one inch to meet minimum thickness requirements to yield an ideal structural integrity, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

17. Regarding claim 7, Jakel disclosed a siding panel as set forth above where the siding panel overlaps the second siding panel, in Figure 12, Jakel clear shows a modified version of Figure 2 with the planar second surface forming an angle with the vertical wall, but Jakel does not disclose the angle being between 1-10 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention

was made to an angle between the planar second surface and vertical wall about 1-10 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

18. Claims 9-10, 12-13 25-26, 30 are rejected as being unpatentable over the Jakel in view of DeFord et al. (U.S. PG Pub 2002/0139082).

19. Regarding claims 9 and 10, Jackel disclose a siding panel assembly, comprising at least first and second siding panels (50, Figures 1-3b and 12) attached to a vertical wall of a structure, each of said siding panels being a rectangular shaped panel having front (52) and rear faces (51), first (55) and second (56) side faces, and top (53) and bottom (54) faces, said first siding panel angled such that a bottom end of said first siding panel overlaps a top end at least a portion of said second siding panel, said rear face of at least said first siding forming a sloped, substantially planar first surface (1<sup>st</sup> Planar Surface) defined from said first side face to said second side face that extends, in substantially continuous planar form, from said top face to a transition region (Transition Region) and shaped sitting substantially flush with a portion of said vertical wall, said rear face having a substantially planar second surface (Planar 2<sup>nd</sup> Surface) occupying a majority of said rear face defined from said first side face to said second side face that extends, in substantially continuous planar form, from said bottom face to said transition region, wherein said siding panels are secured to said vertical wall at least in part by a series of fasteners (illustrated in figures 3b and Figure12 at "166")

extending through said respective siding panels and into said vertical wall, wherein at least some of said fasteners are disposed through said planar first surface sitting substantially flush with the portion of the vertical wall, wherein said vertical wall inherently provides support for said rear surface against burst fractures from said fasteners. Jakel does not disclose a reinforced area proximate to a top end of the rear face. However, Deford et al. teaches that it is known in the art to have a siding panel that comprises of a embedded reinforcement layer that comprises of scrim (para [0016], [0035], [0089]-[0090]) to improve strength and adequately improve the resistance and impact of bending torques that are applied to building under wind loading conditions or other conditions normally faced by building structures. There fore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the siding panel as disclosed by Jakel with the reinforcement as taught by DeFord et al. to provide a siding panel that was lightweight, economical and maintained the structural integrity and adequate reinforcement to resist forces that a building is normally subjected.

20. Regarding claims 12 and 13, Jakel and Deford discloses an assembly as set forth above installed by a plurality of nails ("166", Fig. 1 and Fig. 12). The limitations of the nails being installed by a "blind nail method" or "a face nail method" is considered a product by process limitation, therefore claims 12 and 13 are Product-By-Process claims.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In *re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966.

21. Regarding claim 15, Jakel and DeFord discloses a siding panel as set forth above with the planar first surface (1<sup>st</sup> Planar Surface) having a height, but Jakel does not specify the height as being about at least one inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a planar first surface of about at least one inch to meet minimum thickness requirements to yield an ideal structural integrity, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

22. Regarding claim 16, Jakel discloses in Fig. 12 the planar first surface sloping at an angle that substantially matches an angle between the planar second surface and the wall created by the overlap.

23. Concerning method claims 17, 19, 22-24 in view of the structure disclosed by Jakel and DeFord as set forth above, the method of installing the siding panel would have been obvious, since it is the normal and logical manner in which the panel could be installed.

24. Claims 25-26 and 30 are rejected as set forth in claims 1, 3, 7 and 9 above.

25. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jakel (U.S. Patent No. 5,465,547) and DeFord et al. (U.S. PG Pub 2002/0139082), further in view of the Applicant's Admitted Prior Art (AAPA).
26. Regarding claim 11, Jakel and DeFord discloses the siding panel as set forth above, but does not specify the panel as being a clapboard, however AAPA teaches that a clapboard is a commonly used as a siding panel installed on a wall of a structure. Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to have specified the use of clapboard as a typical choice of a siding panel.

### ***Response to Arguments***

27. Applicant's arguments filed 12/23/2008 have been fully considered but they are not persuasive. Applicant argues that Jakel (U.S. Patent No. 5, 465, 547) does not teach or suggest "a region of increasing thickness that extends from the top face to a transition region where the rear face in this region of increasing thickness forms a substantially planar first surface defined from said first side face to said second side face that extends, in substantially continuous planar form, from said top face to said transition region, along with the said rear face having a substantially planar surface occupying a majority of said rear face defined from said first side face to said second side face that extends, in substantially continuous planar form, from said bottom face to said transition region."

28. In response to applicant's argument, the examiner respectfully disagrees. In the highlighted region in Figure 3b presented in the Interview Summary on 11/24/2008 and above as well as discussed in the interview, the examiner considers the hollow cavities 70, 71, and 72 be reasonably considered as a plane that is parallel but distal to the plane of the highlighted regions. The highlighted region is deemed to be a continuous plane, where there are no cavities or protrusions formed within the highlighted region itself. The highlighted region, in a rectangular fashion, can be traced from top to bottom as well as both sides any discontinuities. The rear face can be reasonably be broken up into three regions, as claimed by applicant and illustrated by examiner, with 2nd planar region to be reasonable considered to occupy the majority of the rear face. Therefore, the examiner maintains that Jakel does teach and suggest the applicants claimed invention.

### ***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES J. BUCKLE JR whose telephone number is (571)270-3739. The examiner can normally be reached on Monday-Thursday, Alternating Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian Glessner  
Examiner  
Art Unit 3633

JJB

/Robert J Canfield/

Supervisory Patent Examiner, Art Unit 3635